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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
LETT, THOMAS J	
ART UNIT	**PAPER NUMBER**
2625	

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/843,746	SENDA, TAMOTSU	
	Examiner	Art Unit	
	Thomas J. Lett	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 February 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *5-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *5-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *30 April 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Response to Arguments

1. Applicant's arguments filed 09 February 2006 have been fully considered but they are not persuasive.

With respect to Applicant's remarks on page 6 regarding a relay box having a recess, Applicant asserts that the Examiner inadvertently interpreted Ono et al's board 14c as a recess of case 12. A recess is indeed illustrated in Fig. 1 of Ono et al. The recess is formed by heights 14b and plate 14a to protect the "field of view" of CCD 3 and optical system 2. The recess of Ono et al would also protect the scanner from dirt and scratches.

With respect to Applicant's remarks on page 7 regarding Ono et al's alleged failure to disclose manual scanning of a manuscript using the reading section, the Examiner notes that the reading performed by the "image pickup section 6" of Ono et al is performed manually at the push of a button (para. 0019). If Applicant means that the reading section can be moved manually over a document sheet, Examiner has changed the rejection to a 35 USC § 103 based rejection that uses the teaching of a wand attached to a base that is capable of manual or motion scanning of a manuscript.

With respect to Applicant's remarks on page 7 regarding Tsai's failure to disclose a relay box having a recess, or a handy scanner body with a narrow bottom surface (new matter) and operable to allow manual scanning. The Tsai reference is not relied upon for those features. The Tsai reference is relied upon for the teaching of reducing EMI to the scanning engine.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 5-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant points out that the handy scanner body is narrow, with a narrow bottom surface (p4, para. 0020). The term "narrow" is subjective and the original written description does not contain a description as to the degree of narrowness. The dimension of narrow is not compared to, or referenced to, some other dimension. If the narrow feature of the invention is critical to the instant application, it should be disclosed in the original disclosure enough to allow Examiner to consider its importance. The term "narrow" did not appear in the original claims, original drawings, or original specification and is therefore new matter. The drawings are presented to the Examiner without scale. Examiner could interpret the bottom surface as being "wide" enough to read a document or "narrow" in its ability to read an enormous map. There are no legends stipulating the physical dimensions of the scanner. While one dimension appears smaller than the other dimension, the smaller dimension may not necessarily be "narrow".

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "narrow" in claim 5 is a relative term which renders the claim indefinite. The term "narrow" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Narrow is indefinite in that it cannot be ascertained in what relationship it is being compared to.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 5, 6, 9, 10, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ono et al (JP409116709A) in view of Wicker et al (USPN 4,792,859).

With respect to claim 5, Ono et al disclose a handy scanner (image reading device, see Fig. 1) comprising:

a handy scanner body (image pickup section case 6) including a reading section (CCD 3) on a narrow bottom surface (section 6 has a narrow side and a wide side as shown in Fig. 2) thereof;

a relay box (case 12) having a recess (plate 14a) for receiving said handy scanner body (image pickup section 6) so as to protect said bottom surface of said handy scanner body, said relay box being operable to relay signals (using control unit 15c, memory 15b, A/D converter 15a) between said handy scanner body and a device (via interface 15e and cable 11);

a first cord (cable 5) for connecting said handy scanner body (image pickup section 6) to said relay box (case 12);

a terminal (interface 15e) for establishing an electrical connection with the device; and

a second cord (cable 11) for connecting said relay box (case 12) to said terminal (interface 15e).

Ono et al do not expressly disclose that said handy scanner body being operable to allow manual scanning of a manuscript using said reading section so as to perform read-in of the manuscript.

Wicker et al teach of an elongated digitizing wand 18 connected to a base for manual scanning of a manuscript. The digitizing wand is connected to a connector cable 22 to transfer digital signals to the base for processing (col. 7, lines 12-30).

Ono et al and Wicker et al are analogous art because they are from the similar problem solving area of scanning. At the time of the invention, it would have been

obvious to a person of ordinary skill in the art to add the manual scanning feature of Wicker et al to the handy scanner of Ono et al in order to obtain a scanner capable of manual scanning of a document surface. The motivation for doing so would be to scan odd-sized or over-sized documents.

With respect to claim 6, Ono et al disclose a handy scanner of claim 5, wherein said recess is formed in a top surface of said relay box, and said recess and said handy scanner body are shaped and arranged so that said relay box (case 12) receives said handy scanner body (image pickup section case 6) such that said bottom surface of said handy scanner body faces a bottom surface of said recess (see Fig. 1).

With respect to claim 9, Ono et al disclose a handy scanner of claim 5, wherein said relay box includes a fastener for fixing (heights 14b for positioning the image reading device 6 of Fig. 1) said handy scanner body (image pickup section case 6) within said recess.

With respect to claim 10, Ono et al disclose a handy scanner of claim 9, wherein said recess is formed in a top surface of said relay box, and said recess and said handy scanner body are shaped and arranged so that said relay box receives said handy scanner body such that said bottom surface of said handy scanner body (image pickup section case 6) faces a bottom surface of said recess (see Fig. 1).

With respect to claim 15, Ono et al do not expressly disclose the handy scanner of claim 5, wherein said recess is shaped to allow said handy scanner body to be fitted within said recess.

Wicker et al teach of an elongated digitizing wand 18 whose body is retained within brackets shaped to allow the wand 18 to be fitted within (col. 6, lines 45-65).

Ono et al and Wicker et al are analogous art because they are from the similar problem solving area of scanning. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the bracket feature of Wicker et al to the handy scanner of Ono et al in order to fit the body within the base holder. The motivation for doing so would be to retain the scanning device.

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ono et al (JP409116709A) in view of Wicker et al, and further in view of Tsai et al (USPN 6,084,691).

With respect to claim 7, Ono et al as modified does not disclose a handy scanner of claim 5, wherein said relay box includes an interfering electromagnetic wave reduction noise filter although Ono et al does disclose a turnable filter 16a. Tsai et al discloses a scanner that is integrated into a computer (relay box) and has a housing to reduce electromagnetic interference to the scanning engine, col. 3, lines 60-66 and see Fig. 2A). Ono et al as modified and Tsai et al are analogous art because they are from the similar problem solving area of noise reduction. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the noise-reduction housing feature of Tsai et al to the case 12 of Ono et al as modified in order to obtain case with a filter to restrict unwanted noise. The motivation for doing so would be to obtain a clean and undistorted image signal.

6. Claims 8 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ono et al (JP409116709A) in view of Wicker et al, and further in view of well-known prior art.

With respect to claim 8, Ono et al as modified does not disclose a handy scanner of claim 5, wherein said relay box including said interfering electromagnetic wave reduction noise filter has a one-piece construction. Examiner notes that it was well-known in the art to add suppression filters to reduce EM interference. In addition, a filter of one-piece construction was well-known in the art. The motivation to construct the filter in this fashion would allow for a smaller circuit footprint in order to save space and for simple circuit construction.

With respect to claim 11, Ono et al as modified does not disclose a handy scanner of claim 5, wherein said first cord is detachably connected to each of said handy scanner body and said relay box. Although Ono et al as modified does not disclose a detachable cord or cable, it was well-known in the art to use detachable cabling for electrical devices. The motivation would be to interface with USB compliant devices or to increase the transfer speed of data.

With respect to claim 12, Ono et al as modified does not disclose a handy scanner of claim 5, wherein said terminal comprises a USB jack connected to said second cord. Although Ono et al as modified does not disclose a USB connection jack, it was well-known in the art to use USB interfaces for electrical devices. The motivation would be to quickly interchange a defective subassembly or interface with another device.

With respect to claim 13, Ono et al as modified does not disclose a handy scanner of claim 5, wherein said bottom surface of said handy scanner body (image pickup section case 6) comprises transparent glass. Examiner notes that Ono et al as modified does disclose the use of a transparent acrylic board 14c. Although Ono et al as modified choose to use an acrylic plate, it was well-known in the art to use plate glass as an alternative plate.

With respect to claim 14, Ono et al as modified disclose a handy scanner of claim 13, wherein said recess is formed in a top surface of said relay box, and said recess and said handy scanner body (image pickup section case 6) are shaped and arranged so that said relay box receives said handy scanner body such that said transparent glass (transparent acrylic board, see Examiner note with respect to claim 13) of said bottom surface of said handy scanner body faces a bottom surface of said recess (see Fig. 1).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Lett whose telephone number is (571) 272-7464. The examiner can normally be reached on 7-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TJL

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